Application Number 09/982,587	Art Unit 1745	Rejection Mail Date 30-May-03	Examiner RUTHKOSKY, MARK	Reviewer Nguyen, Khanh

Rejections Made

The office action contains rejections made under the following statutes:

☑ 35 U.S.C. 102

☑ 35 U.S.C. 103

☐ 35 U.S.C. 112, first paragraph, written description

☐ 35 U.S.C. 112, first paragraph, enablement

☐ 35 U.S.C. 112, second paragraph

☐ 35 U.S.C. 101 (utility)

☐ 35 U.S.C. 101 (non-statutory subject matter)

☐ Double Patenting (statutory, ODP)

☐ Other (e.g., Best Mode)

Application Number	Art Unit	Rejection Mail Date	Examiner	Reviewer
09/982,587	1745	30-May-03	RUTHKOSKY, MARK	Nguyen, Khanh

Omitted Rejections

Is there a potential clear error for omitting a rejection? (The rejection you propose must be reasonable)   Yes   ○ No

If yes, check all that apply

   35 U.S.C. 102

   35 U.S.C. 103

   35 U.S.C. 112, first paragraph, written description

   35 U.S.C. 112, first paragraph, enablement

   35 U.S.C. 112, second paragraph

   35 U.S.C. 101 (utility)

   35 U.S.C. 101 (non-statutory subject matter)

   Double Patenting (statutory, ODP)

   Other (e.g., Best Mode)

Application Number	Rejection Mail Date	Reviewer
09/982,587	30-May-03	Nguyen, Khanh

Correctness of 35 U.S.C 102 Rejections

Were all 35 U.S.C 102 rejections reasonable?
(No indicates potential clear error)

⊙ Yes ○ No

If no, indicate the problem (check all that apply)

☐ Claimed features not found in the reference.

☐ Wrong subsection of 35 U.S.C. 102 used.

☐ Date of the reference no good.

☐ Inherency applied improperly.

☐ Improper official notice.

☐ Other

Comments:

Clarity of 35 U.S.C 102 Rejections

Were all 35 U.S.C. 102 rejections formulated in a clear manner?   ⊙ Yes ○ No

(No indicates potential clear error)

Were claim limitations matched to the art?   ⊙ Yes ○ Sometimes ○ No

Was any statement of inherency clearly explained?   ⊙ Yes ○ Sometimes ○ No ○ N/A

Comments:

35 U.S.C 102 Rejection(s) That Should Have Been Made

Give a brief description of the proposed 35 U.S.C. 102 rejections(s) that should have been made:

Origin of Prior Art used in the proposed 35 U.S.C. 102 rejection(s) above

☐ of record

☐ not of record (attach search logic/documentation)

☐ East   ☐ EPO   ☐ Other

☐ West   ☐ JPO

☐ NPL   ☐ Derwent

Comments:

Application Number	Rejection Mail Date	Reviewer
09/982,587	30-May-03	Nguyen, Khanh

Section III. 35 U.S.C. 103

Correctness of 35 U.S.C 103 Rejections

Were all 35 U.S.C 103 rejections reasonable? ◉ Yes ○ No

(No indicates the presence of a potential clear error

If no, indicate the problem (check all that apply)

☐ Claimed features not found in the reference.

☐ References not combinable.

☐ Date of the reference no good.

☐ Improper motivation.

☐ No reasonable expectation of success.

☐ Improper Official Notice taken.

☐ Other

Comments:

Clarity of 35 U.S.C 103 Rejections

Were all 35 U.S.C. 103 rejections formulated in a clear manner? ◉ Yes ○ No

(No indicates potential clear error)

Were claim limitations matched to the art?	◉ Yes	○ Sometimes	○ No
Were the differences clearly stated?	◉ Yes	○ Sometimes	○ No
Was the modification or combination of references clearly explained	◉ Yes	○ Sometimes	○ No
Was the motivation/reasons for obviousness present?	◉ Yes	○ Sometimes	○ No

Comments:

Except for the typo error which fails to identify Nishida is the JP 2000-021418, not GB 2,326,017, the rejection is clear and complete.

35 U.S.C 103 Rejection(s) That Should Have Been Made

Give a brief description of the 35 U.S.C. 103 rejection(s) that should have been made:

Origin of Prior Art used in the proposed 35 U.S.C. 103 rejection(s) above

☐ of record

☐ not of record (attach search logic/documentation)

☐ East   ☐ EPO   ☐ Other

☐ West   ☐ JPO

☐ NPL   ☐ Derwent

Comments:

Application Number	Rejection Mail Date	Reviewer
09/982,587	30-May-03	Nguyen, Khanh

SECTION XI. File Wrapper

Reasons for Allowance (R/A)

Did the Examiner write a Reasons for Allowance (R/A)?　　　Yes　　No　　° N/A

If yes,

Is the R/A clear and complete?　　　Yes　　No

If no,

Does the record as a whole indicate a R/A was necessary?　　　Yes　　No

Comments:

Interviews

Was there an interview regarding the merits of the case relevant to the action reviewed?　　　Yes　　◉ No

If yes,

Was Summary Form PTOL-413 completed?　　　Yes　　No

Is the record of the interview clear and complete?　　　Yes　　No

Comments:

Claims

Were claims treated in an inappropriate manner on non-substantive issues?　　　Yes　　◉ No

If yes,

☐ claims are present that were not addressed.

☐ claims previously withdrawn from consideration should have been cancelled.

☐ improper dependent claims were not properly treated.

☐ other

Comments:

Sequence Rules

Does the application contain nucleotide and/or amino acid sequences?　　　Yes　　° No

If yes,

Did the examiner properly handle Sequence Compliance Issues?　　　Yes　　No

Comments:

Application Number	Rejection Mail Date	Reviewer
09/982,587	30-May-03	Nguyen, Khanh

Section XIII. Other Issues

Were all claims for priority properly treated?	° Yes	No	N/A
If a restriction was made, was it proper?	Yes	No	° N/A
Were all matters of substance in applicant's response and affidavits/declarations evaluated sufficiently?	Yes	No	° N/A
Other issues?	° Yes	No	

Figure 19 should be labelled as "Prior Art".

Comments:

Application Number	Rejection Mail Date	Reviewer
09/982,587	30-May-03	Nguyen, Khanh

Section XIV. Indicia of Commendable/Outstanding

Patentability Determination: Indicia of Commendable/Outstanding

The record developed by the examiner shows an indication of allowable subject matter at the earliest time which is consistent with the file record and prosecution of the application. ☐Yes

Through the rejections and arguments made by the examiner, an appropriate line of patentability is established which results in amendment(s) properly limiting the scope of an applicant's claims. ☐Yes

The search record in the application clearly shows that the examiner construes the claimed subject matter in its broadest reasonable interpretation and seeks to develop prior art from the appropriate peripherally related art areas. ☐Yes

Action Taking: Indicia of Commendable/Outstanding

The statements of rejection, objection, and response to arguments clearly and concisely present the positions taken or recommended in the resulting Office actions including a thorough substantive explanation to convey those positions to the applicant. ☑Yes

The Office action usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. ☑Yes

The Office action indicates that the principle of compact prosecution is being fully followed. Note, the principle of compact prosecution comprises conducting an initial search which is as complete as possible including consultation with an expert in the art where the examiner lacks such expertise (see search guidelines); placing art of record which meets both the concept and the wording of the claims as well as other art which is pertinent to significant though unclaimed features of the disclosed invention; and issuing a first Office action which clearly explains the examiner's position on each essential issue in such detail that absent some unexpected consideration the next Office action may be made final. ☑Yes

Patent Examining Function: Indicia of Commendable/Outstanding

Check one of the following statement if applicable:

☐ The Office action is formulated to advance the prosecution, correct other informalities, and develop a complete file wrapper record. The Office action also is such that it leaves little room for improvement. The Office action clearly and concisely presents the positions taken.

☑ The entire Office action is complete and accurate and does not require any substantial revision. The Office action effectively conveys the positions taken.

Comments:

Application Number	Rejection Mail Date	Reviewer
09/982,587	5/30/03	Nguyen, Khanh

Section XII. "X" Actions

1- Clearly wrong 102 or 103 such that a claimed feature(s) from an independent or dependent claim is not taught and no other appropriate art rejection of that claim was made

If Yes

    Independent claim(s) only

    Dependent claim(s) only

    Both dependent and independent claim(s) only

2- No motivation statement in a 103 rejection

If Yes

    ☐ Independent claim(s) only

    ☐ Dependent claim(s) only (only check this if the motivation for the independent claim(s) would not cover the dependent claim(s))

    ☐ Both dependent and independent claim(s)

☐ 3- "Shotgun" 102 or 103 rejection that deals with all claims in that rejection

☐ 4- Clearly incomplete actions including restrictions

☐ 5- The action copied (or substantiall copied) the prior office action with no response to substantive arguments made by applicants either in response to the previous action's rejection or restriction

☐ 6- A 131 or 132 affidavit or declaration was not treated

☐ 7- An overly broad claim found during a review of allowed or allowable claims, or allowable subject matter, using a 2nd pair of eyes standard

8- Either a lack of utility under 101 or lack of enablement or writen description under 112 1st

Comments:

Application Number	Rejection Mail Date	Reviewer
09/982,587	30-May-03	Nguyen, Khanh

Search

Initial Data Capture Points

Was art provided from an ESS before first action?	Yes	No	
Was any IDS improperly treated?	Yes	○ No	N/A
Was a text search performed by the Examiner?	○ Yes	No	
Was it non-patent literature?	Yes	○ No	
Is the search strategy printout present?	○ Yes	No	N/A
Was the inventorship searched by the Examiner?	Yes	○ No	
If any TC or specialized art has identified specific search requirements in addition to or in exclusion of the above requirements, were these specific requirements complied with?	Yes	No	○ N/A
Were foreign patent documents cited by the Examiner on an 892?	○ Yes	○ No	
Were NPL documents cited by the Examiner on an 892?	Yes	○ No	
Did the Examiner perform a new search in a 2nd/subsequent action?	Yes	No	○ N/A
Did the Examiner update all searches in a subsequent action?	Yes	No	○ N/A
Did an ESS submit a new search report in a 2nd/subsequent action?	Yes	No	N/A
Was there new art found by the Examiner that was applied in a 2nd/subsequent action?	Yes	No	○ N/A
Has a search been performed by the Reviewer?	Yes	○ No	

Overall Rating of the Search

○ Adequate

○ Less than Adequate

Comments:

The database search was conducted as evidenced by the printed searched logic statements and the citation of the references in Form 892. However, the database search has not been documented. It's not evidenced that the classification search has been conducted.